

REMARKS

Please consider the foregoing amendments and the following remarks. Claims 1, 5, 6, 10-32 and 36 are currently pending in this application.

Elections/Restrictions

The Examiner withdrew newly submitted claims 33-55 and 38-41 as being directed to a non-selected invention. Applicant does not traverse. Claims 33-55 and 38-41 have been canceled for potential prosecution in divisional and/or other continuing applications.

Claim Rejections – 35 USC § 112, ¶1

Claims 1, 5-6 and 10-20 and 31 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1-20 and 31 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In both cases, the Examiner asserted that the claim limitation that an “electronic document to be filed with said receiving agency server by said web server in a manner that said receiving agency computer believes that it is in direct communication with said client machine” is unsupported by the specification.

Applicant respectfully traverses. Applicant’s specification and drawings clearly provide written description and enablement for such a limitation. For example, the Background section of Applicant specification gives an example of one limitation of the prior art to be solved by an exemplary embodiment of Applicant’s invention:

It has been difficult to handle these multiple levels of representation in the past with electronic document filing systems, since such systems tend to infer that the client or its immediate representative is the one actually electronically filing the document. Applicant’s Specification, page 2 lines 12-14.

This passage clearly indicates that a problem encountered in the prior art is that the most prior art electronic document filing systems only deal with the person actually filing the document (i.e. a client or its immediate representative). Applicant's solution to this problem is to make the receiving agency computer believe that it was in direct communication with a client despite the intermediary of its secure web server. This is an important aspect of an exemplary embodiment of the invention because by masquerading the intermediary as a client, no modification to the receiving agency computer is required in order to deal with the secure web server.

The fact that the secure web server acts as an intermediary to the receiving agency computer is found at multiple locations in the specification. For example:

In the present invention, a secure website of, for example, the World Wide Web system of the Internet, is used as an intermediary between a client and an electronic document filing system. Applicant's Specification, page 3, Lines 3-5. (emphasis added)

The "believes that it is" language is also used elsewhere in the specification as follows:

The present invention also facilitates the filing of electronic documents through multiple levels of representation. The client interacts directly with the secure web site. However, the applicant preferably interacts with the secure web site in a transparent fashion such that it believes that it is dealing with its representative, the client. In this way, the client is the sole representative of the applicants and becomes the applicant's interface for the transaction. Applicant's Specification, page 4, lines 10-14. (emphasis added)

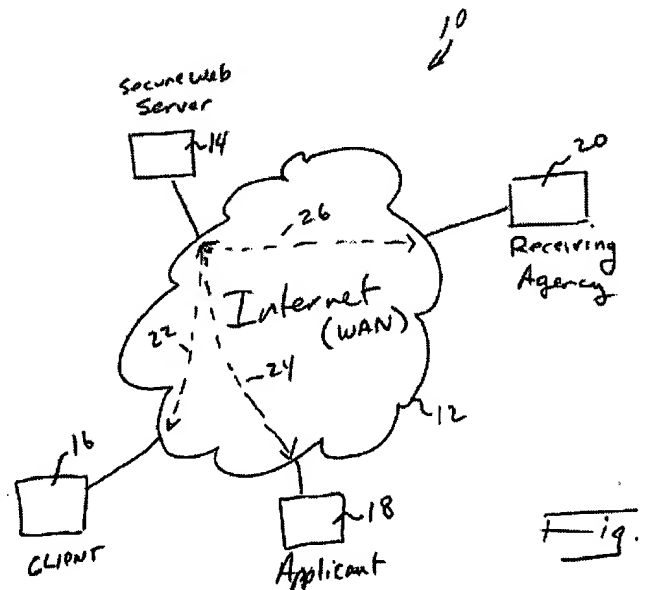
In this example, the applicant machine is interacting with the secure website while it "believes" that it is interacting with the client machine. This is completely analogous to the receiving agency computer believing that it is in direct communication with the client machine even though it is actually communicating with the secure web site.

This is further supported by the following passage, where the web server is described as "an interface" between the client machine and the agency server:

The web server 14 serves as an interface to the receiving agency server 20, the client machine 16 providing information 22 to the web server 14 forming at least a part of an electronic document to be filed with the receiving agency server 20 by the web server 14. Applicant's Specification, page 7, lines 20-22. (emphasis added)

In the claimed exemplary embodiment, a client machine provides information to the web server and the web server creates the electronic document to be filed with the receiving agency computer. As noted above, the receiving agency computer generally only receives electronic documents from a client and, as such, the receiving agency computer must "believe" that the document being provided by the secure web site is a document being submitted directly from a client.

The figures, and in particular Fig. 1 also makes it clear that the client and the receiving agency computer are not in direct communication. Since, as noted above, receiving agents deal with clients, the intermediary of the web site causes the receiving agency server to "believe" that it is communicating with a client.



As yet another example, the web server can provide payment to the receiving agency computer. Since, as noted above, receiving agency computers usually receive payments from the clients, it is clear that it “believes” that the web server is the client. See, for example:

Also, preferably, the web server 14 transacts a financial transaction with the receiving agency server 20 on behalf of the client machine 16. For example, credit card or deposit account information can be transmitted to the receiving agency computer from the secure web server 14. This has the advantage of not requiring that the client or applicant provide this form of payment, i.e. they can be billed for the service. Applicant’s Specification, page 8, lines 4-8.

Applicant therefore believes that the claim limitation that an “electronic document to be filed with said receiving agency server by said web server in a manner that said receiving agency computer believes that it is in direct communication with said client machine” is clearly supported by the specification and drawings. Nonetheless, and solely to expedite that prosecution of this application, Applicant has amended the claims so that the limitation is that “the web server serves as an interface to said receiving agency computer.” This language is clearly supported by the specification and drawings including Fig. 1 and Applicant’s Specification, page 7, lines 20-22 as set forth above. Applicant reserves the right to introduce the removed language at a future date.

Applicant respectfully requests that the rejections under 35 USC § 112, ¶ 1 be withdrawn.

Claim Rejections – 35 USC § 103(a)

Claims 1, 5-6, 12-15, 31, and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,493,722 of Daleen et al. (hereafter “Daleen”) and further in view of U.S. Patent No. 6,023,684 of Pearson (hereafter “Pearson”). Claims 10-11 and 16-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson and further in view of U.S. Patent No. 5,857,191 of Blackwell, Jr. et al. (hereafter “Blackwell”). Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson and further in view of U.S. Patent No. 5,347,477 of Lee (hereafter “Lee”). Claims 21 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Patent Application No. 2001/0011250 of Paltenghe et al. (hereafter “Paltenghe”) and further in view of Daleen. Claims 22 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe and Daleen and further in view of U.S. Patent No. 5,740,361 of Brown (hereafter “Brown”). Claims 23, 25-26, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen and Brown and further in view of U.S. Patent No. 5,604,802 of Holloway (hereafter “Holloway”). Claims 24 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Brown, and Holloway and further in view of U.S. Patent No. 6,122,622 of Wiitala et al. (hereafter “Wiitala”).

The Cited Art

Daleen describes a system, a method and a computer readable medium for distributing messages from a third-party to a group of subscribers by using subscriber information and subscriber preferences stored in a database so that the group of subscribers can form a community to negotiate a group purchase of a good and/or service from the third party. A subscriber selection system is used for querying the database using one or more subscriber criteria to form a group of one or more

subscribers. The one or more subscriber criteria used to query the database is chosen by the third party, which allows the subscriber selection system to form a group of subscribers who satisfy the criteria for a type of subscriber to which the third-party wants to send a message, such as an advertisement. A billing system, which is coupled to the database receives one or more messages from a third-party and then provides the one or more messages from the third party to the group of subscribers that was formed by the corresponding query of the database. This allows the messages from the third-party to be distributed to the group of subscribers without revealing to the third party any of the potentially valuable or sensitive subscriber information stored in the database. In other words, all that a third-party knows is that its message is being sent to a group of subscriber who meet the criteria which the third-party selected. The message includes a contact address which is sent along to the subscribers in the group to form a community for purchase of a good and/or service from a third party. The group of subscribers formed is sent the contact address with the messages received from the third party. The group purchase allows individuals and businesses to reduce costs by buying items in quantities.

Pearson describes a three tier financial transaction system having a local data memory. The three tier system includes a client interface, an application service, a host interface, and a local data memory. The client interface communicates data messages between a client program and the financial transaction system. The client interface converts client requests to a format compatible with the application service so the application service may process client requests from client programs. At the initiation of a logical session with a client program, the application service refreshes data for the customer associated with the client program using data obtained from a back end processing system through the host interface. The data in the local data memory is then used by the application service for processing client requests during the logical session. Response data generated by the application service is provided to the client interface for presentation to the client program. Communication between the client program and the client interface is preferably performed over an open communication network. The

local data memory permits the processing of the client service request to be decoupled from the updating of the back end processing system to improve response times for client request processing.

Blackwell describes a web browser which communicates through a secure local proxy to a web server that has an interface for secure communications. The application server has an application program conforming to the CGI programming model that can run continuously as a process and can maintain state information, such as pointers to next records, thus requiring less computational and memory overhead for a succession of requests.

Lee describes a pen-based form computer using "Form" as the operation metaphor between users and the computer, which allows a user to directly operate the information stored in the computer or any remote systems without learning commands, file names, file types, and other details regarding computer internal structure. It is applicable for use in medical prescription control, order registration control, inventory inquiry control, data collection. It can also be used as a front-end system in a client and server structure. The pen-based form computer includes a pen for data entry, and a complete Multi-tasking Preemptive Pen Based Form Operation software system for form operation metaphor, graphical form making procedure, multiple form data association, multiple form operation language, remote form data accessing, automatic database association, and hand-writing recognition. External keyboard for data entry is acceptable. The preferred embodiment of the invention is within 2 lbs and about the size of a B5 paper. It uses a pressure-sensitive touch panel overlaid LCD for data entry with the pen, and an infrared, RS-232, off-the-shelf modem, and radio transceiver as communication mediums.

Paltenghe describes a system, in which information is the primary asset and in which investments may be made in information, which includes multiple data stores for storing different types of a user's information. The safe, secure and properly authorized transfer of information while preserving individual privacy is provided. The system also provides for secure backup and storage, as well as for ubiquitous and nomadic access

to information while maintaining the privacy of such information. A first data store includes static identification data about a user. A second data store includes moderately dynamic personal data about the user. A third data store includes dynamic demographic information data about the user. An electronic wallet can be used with the system to download selected portions of the data for use by the user. A method of use of the data includes using the data for filling out forms, providing services to the user and allowing merchants to selectively target users for sales while maintaining user anonymity.

Brown describes a system and method for authenticating users and services communicating over an insecure network. Each user and service has a pass-phrase used for authentication. However, the pass-phrases are not revealed during the authentication process as challenge-response techniques are used to keep the pass-phrase secret. In addition, the users and services do not need to know nor do they learn each other's pass-phrases making the process useful in a distributed environment. Pass-phrases are known by an authentication entity with which the service communicates to authenticate both users and services. Users may have identities in and services may support a number of realms, each of which may be viewed as large collection of users (e.g., CompuServe.com). Users choose the realm in which they would like to be authenticated. In one embodiment of the present invention, the system and method are adapted for use with the HyperText Transfer Protocol of the World Wide Web so that secure transactions may be accomplished between users and services communicating via the Internet.

Holloway describes a transaction processing system includes at least one transaction terminal having means to receive characteristic data from a user, which characteristic data is required to generate a characteristic image associated with the user, such as an image of the user's signature, from data stored in a data processing system and logic for generating a transaction message by combining transaction data with the characteristic data in such a way that the transaction data is required to recover the characteristic data from the message. The data processing system includes means

to store the user data, to receive and store the message, to recover the characteristic data from the message using the transaction data, and to reconstruct the characteristic image from the user data using the characteristic data to establish that the transaction was valid by associating the characteristic image with the transaction data.

Wiitala describes an automated system of integrated computer programs and files which facilitates compliance with Chemical Control Laws of different jurisdictions. In one embodiment, the system uses a raw material database file, a formula database file, a manufacturing status database file, a sales status database file, a regulatory worksheet program, and an update program, all residing on a computer system. These files and programs are collectively used to: maintain Chemical Control Law inventories; maintain records of chemical and product Chemical Control Law registrations; provide a basis for automated control of chemical or product manufacturing, distribution, importing and exporting through the generation of country or regional manufacturing and sales status; generate certification letters; generate Chemical Control Law manufacturing and sales statuses for particular countries or regions of the world; and provide real-time updating of a chemical's or product's manufacturing and sales status.

It is noted that much of the cited art is prior art under, for example, 35 U.S.C. 102(e) only. Applicant reserves the right to swear behind such cited art at a later date.

The Cited Art Distinguished

Applicant respectfully traverses the rejections of the claims and specifically traverses many characterizations of the cited art made by the Examiner. Nonetheless, in order to expedite the prosecution of this application, Applicant has amended the claims in order to focus on certain exemplary embodiments. Applicant reserves the right to reintroduce such claims and other claims at a later date in a continuing application without estoppel or limitation.

Furthermore, to the extent that any assertions made by the Examiner as Official Notice or which could be construed to be Official Notice, Applicant traverses and

requests documentation to support the assertions. A non-limiting example includes the "Official Notice" made by the Examiner that "that the filing of trademark application [sic] was notoriously well known in the art at the time of the Applicant's invention." Applicant requests documentation supporting Official Notice to be made of record in this application.

Claims 1, 5, 6 and 10-20

Independent claim 1 includes a web server, a client machine, and a receiving agency server each of which are separate from each other and each of which is coupled to a wide area network for communications purposes. The web server serves as an interface between the client machine and the receiving agency server to pass an electronic document to the receiving agency server for subsequent processing by the receiving agency server. Still further, the web server automatically provides a portion of the electronic document to the client machine in response to a selection originating from the client machine.

By way of example, but not limitation, Daleen does not show a receiving agency server as asserted by the Examiner. A database, such as database 104 of Daleen, does not meet the receiving agency server limitation. There is further no evidence that "Daleen's documents are filed for further processing by a receiving agency ... in accordance with a procedure for which said receiving agency is in some manner responsible" as set forth on page 4 of the Examiner's Office Action. This is purely fabrication and conjecture.

By way of another non-limiting example, none of the prior art shows, teaches or suggests a web server which automatically provides a portion of the electronic document to the client machine in response to a selection originating from the client machine. The Examiner erroneously points to Daleen Fig. 5A (reproduced below), reference 508 as meeting this limitation.

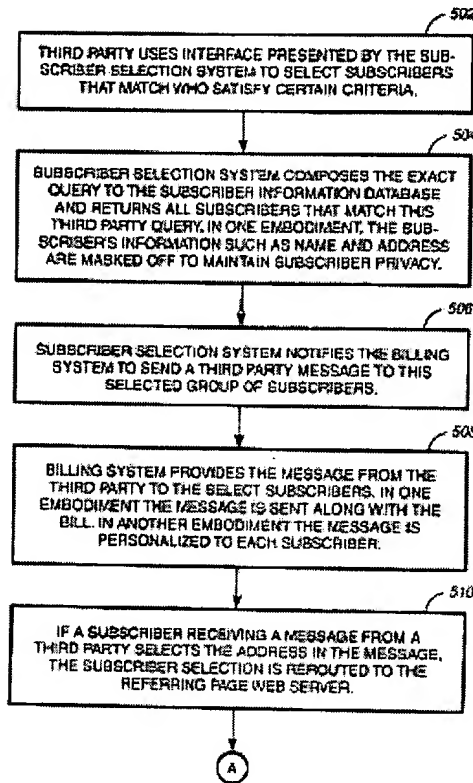


FIG. 5A

Applicant fails to see how reference 508 of Fig. 5A meets the claim limitation of wherein said web server automatically produces at least a portion of said electronic document in response to a selection originating from said client machine. Reference 508 is merely a message from a billing system.

Pearson, contrary to the assertion of the Examiner, does not meet the limitations of a web server coupled to a wide area network and a receiving agency server separate from said web server and coupled to said wide area network such that it is capable of communication with said web server (claim 1, first two limitations). In fact, even if, *arguendo*, the application server 56 is considered to be a receiving agency server, it is coupled directly to the web server 50, not to the wide area network. Even if the web server 50, *arguendo*, were considered to be an "intermediate server", it does not communicate with the application server 56 through the wide area network (Internet 34).

The Examiner is respectfully requested to withdraw the rejection of claim 1 and of claims 5, 6 and 10-20 which are dependent thereon.

Claims 21-26

Independent claim 21 claims an exemplary embodiment where an intermediary web server provides assistance in filling-out an HTML form for a client prior to submitting it to a receiving agency over the Internet. It stores useful information, and at least partially automatically fills in the form based upon client machine input. It then verifies the information based upon stored heuristics before submission to the receiving agency.

Paltenghe is said to teach:

- 1) storing data useful for populating an HTML based form;
- 2) providing the HTML form to a client machine;
- 3) at least partially automatically filling in the form with suitable data selected from the stored data based upon input from a client machine;
- 4) verifying information on the form based upon stored heuristics;
- 5) submitting the form to a receiving agency over a network.

First, it should be noted that the Examiner has paraphrased the claim limitations of claim 21. Various claim limitations of claim 21 are reproduced below with exemplary language removed by the Examiner indicated in italics:

- 1) *prior to the following acts*, storing data useful for populating an HTML based form *on a web server coupled to the Internet*;
- 2) providing *access to* said HTML based form by a client machine *which is separate from said web server and which is coupled to the Internet*;
- 3) at least partially automatically filling in said form *on said web server* with suitable data selected from said data useful for populating said HTML based form based upon input from said client machine;

- 4) verifying *on said web server* information on said form based upon stored heuristics; and
- 5) submitting *by said web server* said form to a receiving agency over the Internet.

It is clear that the Examiner's logic is flawed with this assertion. With reference to Fig. 2 of Paltenghe, the Courtesy Account 31 is stored in the Information Bank 31. A description can be found in paragraph 19 of Paltenghe:

[0019] The system of the information bank can thus provide, in specific aspects, three types of accounts: a courtesy account, a service account, and a value generation account. Basic information can be stored in the information bank courtesy account and used for automated "form filling" services which are useful to the consumer as an easy means for providing personal information to others when and as authorized. This service may also include a digital signing service, a digital signature verification service, and, for example, notary services.

Therefore, to follow the Examiner's logic, the Information Bank 31 is the "*web server coupled to the Internet.*" If this is the case, the Information Bank 31 must create an HTML form for a client, partially fill it in, and verify it before submitting the filled-in form *to a receiving agency over the Internet.* However, there is no receiving agency shown, suggested or described by Paltenghe. Daleen does not cure this problem, since Daleen also does not teach a receiving agency server.

Furthermore, Brown is said to "verify the information" on the form based upon stored heuristics. The Examiner points to column 3, lines 62-63 (reproduced below) with his assertion that "verifying the information" limitation is met by providing a user name and password:

One technique to address this problem is to have the service prompt the user for her pass-phase. For example, a WWW service may display a Hyper-Text Markup Language (HTML) form with two boxes—one that asks for the user for her user name and one that asks her for her pass-phase. A

Applicant respectfully traverses. The account number and password of Brown only indicates that the user is authorized to access the system. Nonetheless, in an abundance of caution, the claim limitation has been amended to indicate that the

verification is to determine that the form is complete and that the information on the form conforms to rules as determined by stored heuristics. This new language has also been added to claim 27.

It is therefore clear that none of the cited art shows, teaches or suggests such the combination of claim 21. The Examiner is respectfully requested to withdraw the rejection of claim 21 and of claims 22-26 which are dependent thereupon.

Claims 27-30

Independent claim 27 is an article claim analogous to the method claim 21 and is patentable over the cited art for at least the same reasons as set forth above, which will not be repeated here for the sake of conciseness and brevity. The Examiner is respectfully requested to withdraw the rejection of claim 27 and of claims 28-30 which are dependent thereupon.

Claim 31

Independent claim 31 is a system claim analogous to the system claim 1 and is patentable over the cited art for at least the same reasons as set forth above with respect to claim 1, which will not be repeated here for conciseness and brevity. In addition, there is the addition of the limitation wherein said web server makes a payment to said government agency for the filing of said electronic document. None of the prior art references cited show or describe such a limitation. While the Examiner points to the Abstract of Wiitala as disclosing that a filing fee, this is clearly erroneous:

[57]

ABSTRACT

An automated system of integrated computer programs and files facilitates compliance with Chemical Control Laws of different jurisdictions. In one embodiment, the system uses a raw material database file, a formula database file, a manufacturing status database file, a sales status database file, a regulatory worksheet program, and an update program, all residing on a computer system. These files and programs are collectively used to: maintain Chemical Control Law inventories; maintain records of chemical and product Chemical Control Law registrations; provide a basis for automated control of chemical or product manufacturing, distribution, importing and exporting through the generation of country or regional manufacturing and sales status; generate certification letters; generate Chemical Control Law manufacturing and sales statuses for particular countries or regions of the world; and provide real-time updating of a chemical's or product's manufacturing and sales status.

Applicant simply fails to see where the Abstract of Wiitala discloses a filing fee at all, let alone one for the filing of an electronic document with a government agency by an intermediary web server. The Examiner is respectfully requested to withdraw the rejection of claim 31.

Claim 32

While the Office Action summary indicated that independent claim 32 was rejected, no specific reasons for rejection were set forth in the Office Action itself. Nonetheless, Applicant believes that claim 32 is patentable over the cited art for at least the same reasons as set forth herein. Applicant respectfully requests that the rejection of claim 32 be withdrawn.

Claim 36

The Examiner indicated that claim 36 was "similarly rejected" as per claim 31. Applicant asserts that claim 36 is patentable for at least the same reasons as set forth in claim 31, which will not be repeated here for conciseness and brevity. Applicant respectfully requests that the rejection of claim 36 be withdrawn.

Conclusion

All claims being allowable, a Notice of Allowance is respectfully solicited.

Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

Date: 09/15/08

A handwritten signature in black ink, appearing to read 'Paul L. Hickman', written over a horizontal line.

Paul L. Hickman
Registration No. 28,516

Correspondence Address:

Customer No. 45965

Telephone: 650-293-3355